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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,080	07/31/2000	Richard N. Burrige	SUN-P4677	4961

7590 05/22/2003

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EXAMINER

GROSS, KENNETH A

ART UNIT

PAPER NUMBER

2122

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/629,080

Applicant(s)

BURRIDGE ET AL.

Examiner

Kenneth A Gross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,23,26-32,35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7,23,26-32,35 and 36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Specification

1. The use of the trademark "JAVA" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-7, 30-32, and 36 contain the trademark/trade name JAVA. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the JAVA programming language and, accordingly, the

a product sold by Sun Microsystems

DM

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identification/description is indefinite. The trademark JAVA should be replaced with generic language.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5-7, 23, 26, 30-32, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins (U.S. Patent Number 6,536,035) in view of “JDK 1.2 Roadmap: All Things New with JDK” by Monica Pawlan, March 1998 (hereinafter Pawlan).

In regard to Claim 1, Hawkins teaches: (a) executing a main program unit a first time (Column 8, lines 5-6); (b) creating at least one library file containing application program files loaded during first execution of the main program unit (Column 8, lines 5-12); (c) executing said main program unit a second time using at least one library file for dynamically loaded program files. Hawkins teaches executing the application on a client, and using the library files dynamically (Column 3, lines 4-7). Hawkins does not teach specifying a system program input. Pawlan, however, does teach the Java Development Kit includes libraries of system program files used in the development of Java programs. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to execute a main program unit a first time and create a library file containing application program files loaded during first execution of the main program unit and executing said main program unit a second time using at least one library

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file for dynamically loaded program files, as taught by Hawkins, where a system program file input is specified and used, as taught by Pawlan, since system files aid in the construction of application programs. Claims 23 and 26 correspond with Claim 1 and are rejected for the same reasons as Claim 1.

In regard to Claim 5, Hawkins teaches that the program files are Java class files and Java archive files (Column 3, lines 9-26). Claim 30 corresponds to Claim 5, and is rejected for the same reasons as Claim 5.

In regard to Claim 6, Pawlan teaches that the system program file input is the Java Development Kit. Claim 31 corresponds to Claim 6, and is rejected for the same reasons as Claim 6.

In regard to Claim 7, Hawkins teaches that the library file is a Java archive file (Column 2, lines 1-15 and Column 8, lines 10-12). Claim 32 corresponds to Claim 7, and is rejected for the same reasons as Claim 7.

In regard to Claim 35, Hawkins teaches storing in at least one program unit field every program unit loaded during execution of a dynamically loaded program (Column 8, lines 5-12). Hawkins does not explicitly teach storing the pathname of every program unit loaded. However, a pathname is an inherent representation of a program unit file. Hawkins also does not specifically teach storing the pathname of the main unit in the main unit field. However, since the main unit is the first program unit to be run, the class file of the main unit will be the first to be loaded, and hence stored in the main program unit during execution. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to store in at least one program unit field every program unit loaded during execution of a dynamically loaded program,

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where the program unit is stored as a pathname, since a pathname is an inherent representation of a file, and storing a pathname reduces the size of the library file, where the main program unit is stored in the main unit field, since the main program is the first to run, and therefore would be stored in the main unit field.

In regard to Claim 36, Hawkins teaches that all program unit fields are stored within a JAR file (Column 2, lines 1-15 and Column 8, lines 10-12). A manifest file is an inherent part of a JAR file, and thus would be included in the main unit field.

3. Claims 2-4 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins (U.S. Patent Number 6,536,035) in view of “JDK 1.2 Roadmap: All Things New with JDK” by Monica Pawlan, March 1998 (hereinafter Pawlan) and further in view of “Special Edition Using Java 2 Platform” by Joseph L. Weber, 1998 (hereinafter Weber).

In regard to Claim 2, Hawkins and Pawlan teach the method of Claim 1 and Hawkins further teaches storing each application program file loaded during execution to a library file (Column 8, lines 5-12), but do not specifically teach setting a first and second pathname for system and application program files. However, since the application and system program files exist on a file system, it is inherent that that would have a pathname associated with them. Weber further teaches that it is possible to set the classpath in the Java SDK environment using the ‘set CLASSPATH’ command so that class files have a certain pathname associated with them.

When the program is executing, it would be obvious to use these pathnames to access dynamically loaded program files, since the program will need the pathname in order to access class files used during execution. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to execute the method of Claim 1 where the application

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program files loaded during execution of the main program unit are stored in a library file as taught by Hawkins and Pawlan, and a first and second pathname for system and application program files are set, and the pathnames are used during execution to load program files, as taught by Weber, since pathnames aid in the storing and locating of files in a file system. Claim 27 corresponds to Claim 2, and is rejected for the same reasons as Claim 2.

In regard to Claim 3, Hawkins teaches: (a) loading a program file when referenced during execution (Column 1, lines 48-57); (b) storing each application program file loaded during execution to a library file (Column 8, lines 5-12). Hawkins does not teach determining whether execution of said main program unit has terminated, however this feature would be obvious, since the method would need to make this determination in order to terminate itself. Claim 28 corresponds to Claim 3, and is rejected for the same reasons as Claim 3.

In regard to Claim 4, Hawkins teaches that the library file comprises a compressed file (Column 2, lines 1-6). Claim 29 corresponds to Claim 4, and is rejected for the same reasons as Claim 4.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Romer et al. (U.S. Patent Number 5,953,534)

Chan et al. (U.S. Patent Number 6,470,494)

Hastings (U.S. Patent Number 5,193,180)

Tock (U.S. Patent Number 5,815,718)

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Jameson (U.S. Publication No. US 2002/0199170)

Bacon (U.S. Patent Number 6,463,581)

Sauntry (U.S. Patent Number 6,349,344)


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth A Gross whose telephone number is (703) 305-0542.

The examiner can normally be reached on Mon-Fri 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A Morse can be reached on (703) 308-4789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

KAG
May 13, 2003


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100